[11443/72]

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	Examiner: P. Smith
Michael WHITMAN	
For: ELECTROMECHANICAL SURGICAL DEVICE	
	Art Unit: 3739
Filed: March 15, 2002	
Serial No.: 10/099,634	

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Commissioner for Patents
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REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

SIR:

This Reply Brief is responsive to the Examiner's Answer dated May 14, 2009 in connection with the above-captioned patent application. For at least the reasons more fully set forth below, as well as the reasons more fully set forth in the "Appeal Brief Pursuant to 37 C.F.R. § 41.37" ("the Appeal Brief"), filed on January 12, 2009, the rejections of claims 1 to 9, 11 to 16, 19 to 21, and 37 to 51 should be reversed.

As an initial matter, the Examiner's Answer, like the Final Office Action, appears to rely on a teaching, suggestion, or motivation to modify or combine the cited references to arrive at the claimed features. *See, e.g.*, Examiner's Answer, page 5, paragraph [03c] ("A skilled artisan without be motivated . . . ."); Final Office Action, page 3, paragraph [07c] ("A skilled artisan would be motivated . . . ."). However, M.P.E.P. § 2143 states that, in order to rely on the teaching/suggestion/motivation rationale in support of an obviousness rejection:

> Office personnel ***must*** articulate the following:
> (1) a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;

> (2) a finding that there was reasonable expectation of success; ***and***
>
> (3) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

(Emphasis added). As set forth in the Appeal Brief, there is no apparent motivation for one of ordinary skill in the art to combine the references in the manner suggested by the Examiner's Answer and the Final Office Action. Further, the present rejection is deficient for at least the additional reason that it does not articulate: (1) a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) a finding of a reasonable expectation of success; or (3) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness. That is, despite adequate guidance by the Supreme Court in the *KSR* decision as well as adequate guidance by the M.P.E.P., a *prima facie* case of obviousness has not been established.

Moreover, even if Noiles and Tsuji were combined as suggested in the Final Office Action and in the Examiner's Answer, the combination would not include all of the features claimed. For example, claims 1, 11, 37, and 40 recite that a moisture sensor is ***disposed within a coupling***, and claim 38 recites that a ***coupling*** includes a moisture sensor. There is absolutely no disclosure, or even a suggestion, by Noiles or Tsuji of a moisture sensor ***disposed within a coupling*** or a ***coupling*** that includes a moisture sensor. That is, there is no disclosure, or even a suggestion, by Noiles or Tsuji that the humidity sensor 22 is ***disposed within a coupling*** or that a ***coupling*** includes the humidity sensor 22. Thus, the rejection raised under 35 U.S.C. § 103(a) are apparently based on improper hindsight.

Thus, for the reasons more fully set forth above and the reasons more fully set forth in the Appeal Brief, the rejections of claims 1 to 9, 11 to 16, 19 to 21, and 37 to 51 should be reversed.

Respectfully submitted,

Dated: July 14, 2009

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